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EXAMINER

KRAWCZEWICZ MYERS, LOUANNE C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1661

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,046

Applicant(s)

MISATO ET AL.

Examiner

Louanne C Krawczewicz Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/26/04, 9/3/04, and 10/4/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/3/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

LK Myers

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DETAILED ACTION

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112 first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. Page 1, line 26, Applicants are requested to set forth in the specification whether the parental cultivar(s) 'Golden Eye' has been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.
- B. Page 2, line 7, Applicants are requested to set forth in the specification whether the cultivar 'Goldie' has been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be

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referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

C. Page 2, line 22, Applicants should insert --known to us-- after "available" as it is in the realm of possibility that another *Bidens* having the same characteristics as the instant plant exists unknown to the inventors.

D. Page 2, line 30, Applicants state "ray flowers". It appears --ray florets-- may be the more appropriate botanical term to use in this instance. Correction to the specification and/or clarification is necessary.

D. Page 2, lines 26 and 28, it appears that Applicants should delete "the" in order to be grammatically correct.

E. Page 3, lines 6 and 27, Applicants state "ray flowers". It appears --ray florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

F. Page 3, lines 8 and 24, Applicants state "ray flower". It appears --ray floret-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

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G. Page 3, line 37, Applicants should insert --of asexual reproduction-- after "generations" in order to clearly set forth the type of reproduction.

H. Page 4, lines 27-32, Applicants should set forth in the specification additional information relative to the instant plant's stem/lateral branches including typical and observed length and quantity.

I. Page 5, lines 1-3, Applicant state "leaflet". It is uncertain if Applicants meant to state leaf instead. Correction to the specification and/or clarification is necessary.

J. Page 5, lines 1-5, Applicants should set forth in the specification additional information relative to the instant plant's leaves including the typical and observed leaf margin descriptors, the typical and observed leaf texture and the typical and observed leaf venation pattern and coloration for both upper and lower surfaces with reference to the employed color chart.

K. Page 5, lines 6-8, Applicants should set forth in the specification additional information relative to the instant plant's petioles including coloration with reference to the employed color chart.

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L. Page 5, lines 4 and 5, Applicants state "137C (moderate yellow green)".

When compared with the RHS dictionary of Color, 137C is in the "Green group".

Correction to the specification and/or clarification is necessary.

M. Page 5, line 5, Applicants state "138B (grayish yellow green)". When

compared with the RHS dictionary of Color, 138B is in the "Green group".

Correction to the specification and/or clarification is necessary.

N. Page 5, lines 10 and 11, Applicants should set forth in the specification

additional information relative to the instant plant's typical and observed

inflorescence depth, the number of inflorescences per plant, and whether or not a fragrance is detected.

O. Applicants should set forth in the specification information relative to the

instant plant's flower buds including diameter, length, shape, and color with

reference to the observed color chart.

P. Page 5, line 12, Applicants state "ray flowers". It appears --ray

florets-- may be the more appropriate botanical term to use in this instance.

Correction to the specification and/or clarification is necessary.

Q. Page 5, lines 13-17, Applicants state "ray flower". It appears --ray

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floret-- may be the more appropriate botanical term to use in these instances.

Correction to the specification and/or clarification is necessary.

R. Page 5, lines 12-19, Applicants should set forth in the specification additional information relative to the instant plant's ray florets including the typical and observed ray floret margin descriptor and the typical and observed texture and shape.

S. Page 5, lines 17-19, Applicants state "7A (brilliant greenish yellow)". When compared with the RHS dictionary of Color, 7A is in the "Yellow group".

Correction to the specification and/or clarification is necessary.

T. Page 5, line 20, Applicants state "disk". It appears --disc-- may be the more appropriate botanical term to use in this instance. Correction to the specification and/or clarification is necessary.

U. Page 5, lines 21 and 24, Applicants state "disk flower". It appears --disc floret-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

V. Page 5, lines 20-24, Applicants should set forth in the specification additional information relative to the instant plant's disc florets including the typical and

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observed disc floret number per inflorescence and the typical and observed width, texture and shape.

W. Page 5, lines 22 and 23, Applicants should set forth in the specification additional information relative to the instant plant's phyllaries including phyllary shape, length, width, apex, base and margin descriptors, texture and coloration (both surfaces) with reference to the employed color chart.

X. Page 5, line 30 and 37, Applicants state "disk floret". It appears --disc florets-- may be the more appropriate botanical and grammatical term to use in these instances. Correction to the specification and/or clarification is necessary.

Y. Page 5, lines 30 and 37, Applicants set forth information relative to the instant plant's reproductive organs. Applicants state "Androecium.- present on the disk floret only." and "Gynoecium.- present on the disk floret only." Typically, the Gynoecium are present on both ray and disc florets. Applicants should review the location of the Gynoecium and Androecium for accuracy. Correction to the specification and/or clarification is necessary.

Z. Page 5, line 36, Applicants should set forth in the specification additional information with reference to the typical and observed amount of pollen produced, such as scarce, moderate or abundant.

AA. Page 6, line 1, Applicants should set forth in the specification additional information relative to the instant plant's reproductive organs including pistil number.

BB. Page 6, line 6, Applicants state "3C (light yellow green)". When compared with the RHS dictionary of Color, 3C is in the "Yellow group". Correction to the specification and/or clarification is necessary.

CC. Page 6, line 8, it appears that Applicants should delete "development has" and insert instead --have-- in order to be grammatically correct.

DD. Page 7, line 3 of the claim, Applicants should insert --plant-- before "named" according to M.P.E.P. 1605 and proper claim format. Correction to the specification is necessary.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Colour Wave Collection catalog (IDS Reference No. 6 filed 9/3/04) with a publication date of 2002 (assumed to be January 1, 2002) (which is more than a year before the instant patent application's filing date) and applicants' admission (IDS paper no. 5 and explanation page 2, lines 8-10) that the subject of this patent application was offered for sale in the United States under "the trade name 'MARIETTA Gold Spark' of the present variety ", 'Sunbidesupa' ". Since applicants admit that 'MARIETTA Gold Spark' and 'Sunbidesupa' are

the same plant, Claim 1 is drawn to a *Bidens* 'Sunbidesupa' subject of the Colour Wave Collection catalog.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.").

Since one skilled in the art could reproduce the plant because it was readily available to the public, then the above referenced publications had an enabling disclosure.

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicants file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance.

Applicants should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

Applicants should note the new amendment format. (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louanne C. Krawczewicz Myers whose telephone number is (571) 272-0979. The examiner can normally be reached on Monday and Thursday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone numbers for the group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent electronic business center whose telephone number is (866)-217-9197 (toll free) or (703) 305-3028 or (703) 308-6845 or email requests to ebc@uspto.gov.

LKM

A handwritten signature in black ink, appearing to be the initials 'LKM' with a stylized flourish.A handwritten signature in black ink, reading 'Kent A. Bell' with a stylized flourish.